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FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 340.00)

Complete if Known

Application Number 09/903,882

Filing Date July 12, 2001

First Named Inventor Ihor Wacyk

Examiner Name Clara Yang

Art Unit 2635

Attorney Docket No. US 010336

METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Order Other None
 Deposit Account:

Deposit Account Number 50-0208
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FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 790	2001 395	Utility filing fee	
1002 350	2002 175	Design filing fee	
1003 550	2003 275	Plant filing fee	
1004 790	2004 395	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1) (\$ 0-			

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims			
Multiple Dependent			

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 88	2201 44	Independent claims in excess of 3
1203 300	2203 150	Multiple dependent claim, if not paid
1204 88	2204 44	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2) (\$ 0-		

**or number previously paid, if greater; For Reissues, see above

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 430	2252 215	Extension for reply within second month	
1253 980	2253 490	Extension for reply within third month	
1254 1,530	2254 765	Extension for reply within fourth month	
1255 2,080	2255 1,040	Extension for reply within fifth month	
1401 340	2401 170	Notice of Appeal	
1402 340	2402 170	Filing a brief in support of an appeal	340.00
1403 300	2403 150	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,370	2453 685	Petition to revive - unintentional	
1501 1,370	2501 685	Utility issue fee (or reissue)	
1502 490	2502 245	Design issue fee	
1503 660	2503 330	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 790	2809 395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR 1.129(b))	
1801 790	2801 395	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 340.00)

(Complete if applicable)

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DOCKET NO.: US 010336
CLIENT NO.: PHIL06-10336

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: IHOR WACYK
Serial No.: 09/903,882
Filed: July 12, 2001
For: SYSTEM AND METHOD FOR CONFIGURATION OF
WIRELESS NETWORKS USING POSITION
INFORMATION
Group No.: 2635
Examiner: Clara Yang

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

The Appellant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner dated May 28, 2004, finally rejecting Claims 1-4 and 9-17. The Appellant filed a Notice of Appeal on September 23, 2004. The Appellant respectfully submits this brief on appeal with the statutory fee of \$340.00.

**DOCKET NO. US 010336
U.S. SERIAL NO. 09/903,882
PATENT**

REAL PARTY IN INTEREST

This patent application is currently owned by Philips Electronics North America Corporation as indicated by an assignment recorded on July 12, 2001 in the Assignment Records of the U.S. Patent and Trademark Office at Reel 011994, Frame 0672.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that are related to, will directly affect, be directly affected by, or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-4 and 9-17 have been rejected pursuant to an Office Action dated May 28, 2004. Claims 5-8 have been objected to as being allowable if rewritten in independent form pursuant to the final Office Action. Claims 1-4 and 9-17 are presented for appeal. A copy of all pending claims is provided in Appendix A, the Claims Appendix.

STATUS OF AMENDMENTS

A response to the Final Office Action was faxed to the Examiner on August 18, 2004. The Appellant is unaware of any Advisory Action received after the faxing of the August 18, 2004 response. The Appellant is also unaware as to the status of the response.

SUMMARY OF CLAIMED SUBJECT MATTER

In independent Claim 1, a system including a wireless controller (156) and one or more nearby devices (150a-n) binds the devices to the controller. (*Application: Fig. 4; page 12, lines 15-23*). The wireless controller transmits an address inquiry signal (221) to an address (ADDR1) of a first one of the devices. (*Application: Fig. 5B; page 18, lines 1-3*). In response, the wireless controller receives a response from the first one of the devices. (*Application: page 18, line 6*). The wireless controller determines (227) whether others of the devices also responded. (*Application: Fig. 5B; page 18, lines 4-6*). If other devices also responded, the wireless controller sends a signal (229) addressed to ADDR1 instructing devices having that address to randomize their addresses. (*Application: Fig. 5B; page 18, lines 6-8*).

In dependent Claim 2, prior to transmitting the address inquiry signal, the wireless controller of the system of Claim 1 sends an address request signal (203) to the devices. (*Application: Fig. 5A; page 16, lines 4-5*). The wireless controller uses the first address received in response (215) to the address request signal as address ADDR1 of a first one of the devices. (*Application: Fig. 5A; page 17, lines 12-16*).

In dependent Claim 3, after sending the signal instructing the wireless devices to randomize their addresses, the system of Claim 2 repeats (232) the actions of sending an address request signal to the devices (203), using the first address received as ADDR1 (215), transmitting an address inquiry signal to ADDR1 (221), receiving one or more responses to the address inquiry signal (227), and, if more than one response is received, sending a signal to ADDR1

instructing devices having that address to randomize their addresses (229). (*Application: Figs. 5A, 5B; page 18, lines 10-11*).

In dependent Claim 4, when the wireless controller of Claim 3 determines that it received a response to the address inquiry signal only from the first one of the devices, the wireless controller sends an identify request signal to address ADDR1 (233), instructing the first one of the devices to provide a sensory output (235) that identifies the device to an operator of the wireless controller. (*Application: Fig. 5B; page 18, lines 18-21*).

In dependent Claim 5, upon receipt of the output identification, the operator of the wireless controller of Claim 4 inputs either a bind command or a skip command (237). (*Application: Fig. 5B; page 20, lines 5-6*). In response to the bind command, the wireless controller binds the first one of the devices (239). (*Application: Fig. 5B; page 18, line 23, to page 19, line 3*). In response to the skip command, the wireless controller leaves the device unbound (243). (*Application: Fig. 5C; page 19, line 23, to page 20, line 3*).

In dependent Claim 6, the binding of the first device to the wireless controller of Claim 5 includes storing a unique address for the first one of the wireless devices. (*Application: page 19, lines 4-8*).

In dependent Claim 7, the binding of the first device to the wireless controller of Claim 6 also includes transmitting a signal to the first one of the wireless devices to reprogram its address from ADDR1 to the unique address (239, 241). (*Application: Fig. 5B; page 18, line 23, to page 19, line 7*).

In dependent Claim 8, the wireless devices of Claim 7 are lamps (150a-n). (*Application: Fig. 4; page 12, lines 15-18*).

In independent Claim 9, a device (150i) that may be bound to a wireless controller (156) includes a processor having an address (153i) and a transceiver (152i). (*Application: Fig. 4; page 13, line 15, to page 14, line 1*). The processor is programmed to transmit a signal including the address (213). The signal is transmitted a pre-determined time period (211) after receiving an address request signal (205). (*Application: Fig. 5A; page 16, lines 5-23*). The processor is also programmed to randomize its address in response to receiving a randomize address signal (231). (*Application: Fig. 5B; page 18, lines 8-10*). The processor is further programmed to transmit a signal (225) in response to receiving an address inquiry signal addressed to its address (223). (*Application: Fig. 5B; page 18, lines 1-4*).

In dependent Claim 10, the processor of Claim 9 is also programmed to reprogram its address when it receives a signal, sent to its current address, that includes a new address. (*Application: page 19, lines 4-7*).

In dependent Claim 11, the device of Claim 10 is a lamp (150i). (*Application: Fig. 4; page 12, lines 15-18*).

In independent Claim 12, a method of binding one or more devices in a neighborhood group into a control group that is controlled together includes the step of (a) requesting the addresses of the devices in the group (203). (*Application: Fig. 5A; page 16, lines 4-5*). The first address received (215) from the devices in response to the address request is (b) considered as an

address (ADDR1) of a first device in the neighborhood group. (*Application: Fig. 5A; page 17, lines 12-16*). The devices in the neighborhood group are (c) queried (221) to determine whether they have address ADDR1. (*Application: Fig. 5BA; page 17, line 23, to page 18, line 3*). A response to the query is (d) received from the first device. (*Application: page 18, line 6*). It is (e) determined (227) whether one or more additional responses from one or more other devices are also received. (*Application: Fig. 5BA; page 18, lines 4-6*). When one or more additional responses are received, all devices having ADDR1 are (f) instructed to randomize their addresses (229). (*Application: Fig. 5BA; page 18, lines 6-8*).

In dependent Claim 13, when it is (e) determined that no additional responses have been received, the method of Claim 12 further includes (f) instructing the first device to mark itself unavailable (241, 243). (*Application: Figs. 5B, 5C; page 19, line 18, to page 19, line 3*). Only available devices respond when the addresses of the devices in the group are requested. (*Application: page 16, lines 8-16*). The steps of the method are repeated (232) until no additional responses are received in step (e). (*Application: Figs. 5A, 5B; page 18, lines 10-11*).

In dependent Claim 14, when it is (e) determined that no additional responses have been received, the method of Claim 13 further includes (g) instructing the first device to provide a sensory output that identifies it to an operator (233, 235). (*Application: Fig. 5B; page 18, lines 18-21*).

In dependent Claim 15, the method of Claim 14 further includes (h) binding the first device as part of the control group and (i) removing the first device from further consideration in

the steps of the method (241). (*Application: Fig. 5B; page 18, line 23, to page 19, line 3; page 20, lines 5-6*). The method is then (j) repeated from step (a) (245). (*Application: Fig. 5C; page 19, lines 18-22*).

In dependent Claim 16, the method of Claim 14 further includes (h) removing the device from further consideration for binding without binding it (243) and (i) repeating the method from step (a) (245). (*Application: Fig. 5C; page 19, line 23, to page 20, line 3*).

In dependent Claim 17, the devices of the method of Claim 12 are lamps (150a-n). (*Application: Fig. 4; page 12, lines 15-18*).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (1) Claims 1-3, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,337,619 to Kowalski et al (“*Kowalski*”) in view of U.S. Patent Application No. 2002/0175705 A9 to Armstrong et al. (“*Armstrong*”).
- (2) Claims 4 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kowalski* in view of *Armstrong* and further in view of U.S. Patent No. 6,133,832 to Winder et al. (“*Winder*”).
- (3) Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Armstrong* in view of U.S. Patent No. Patent No. 5,838,226 to Houggy et al. (“*Houggy*”).
- (4) Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Armstrong* in view of *Houggy* and further in view of U.S. Patent Application No. 2002/0084890 A1 to Guerrieri et al. (“*Guerrieri*”).
- (5) Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kowalski* in view of *Armstrong* and further in view of *Guerrieri*.

ARGUMENT

GROUND 1 — REJECTION UNDER 35 U.S.C. § 103(a) OF CLAIMS 1-3, 12 AND 13

The rejection of Claims 1-3, 12 and 13 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

A. OVERVIEW

Claims 1-3, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,337,619 to Kowalski et al (“*Kowalski*”) in view of U.S. Patent Application No. 2002/0175705 A9 to Armstrong et al. (“*Armstrong*”).

B. STANDARD

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Appellant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does

not produce a *prima facie* case of unpatentability, then without more the Appellant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. (MPEP § 2142).

C. **CLAIM 1**

Claim 1 recites a system that includes:

a wireless controller that binds one or more devices from a neighborhood group of devices to the controller, the controller having
 a processor that processes data and formats signals and
 a transceiver that transmits and receives signals,
the controller in a binding procedure
 transmitting an address inquiry signal to an address (ADDR1) of a first device in the neighborhood,
 receiving back a response to the address inquiry signal from the first device,
 determining whether one or more additional responses to the address inquiry signal are received from one or more of the other devices in the neighborhood group, and
 sending a randomize address signal addressed to ADDR1 if one or more additional responses to the address inquiry signal is received.

Regarding the limitation “transmitting an address inquiry signal to an address (ADDR1) of a first device in the neighborhood,” the Examiner asserts that “the common knowledge of controllers transmitting interrogation signals addressed to specific transponders is taken to be admitted prior art since the Applicant failed to traverse the examiner’s assertion of official notice in the previous Office Action.” *Office Action mailed May 28, 2004, page 5, lines 12-15.* The Applicant traverses this assertion.

The Examiner’s actual statement in the previous Office Action was, “Though Kowalski’s method lacks the step of sending an interrogation signal or address inquiry signal to determine the presence of modules having a specific address, the Examiner takes Official Notice that controllers with the ability to determine whether a specifically addressed transponder is present are well known.” *Office Action mailed December 10, 2003, page 6, lines 5-8.* In the Applicant’s response to

the previous Office Action, the Applicant stated, “The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response.” *Applicant’s Response to Office Action mailed December 10, 2003, page 20, last two lines.* Thus, the Applicant properly traversed the Examiner’s assertion of Official Notice and the asserted common knowledge is improperly treated as admitted prior art in the final rejection.

The Applicant respectfully submits that the assertions made in the Official Notice are not “capable of instant and unquestionable demonstration as being well-known” as required by M.P.E.P. § 2144.03. The Applicant respectfully requests that the Patent Office provide documentary evidence showing that the limitation of “transmitting an address inquiry signal to an address,” as recited in Claim 1, is actually “well known in the art” as asserted in the Office Action.

Regarding the limitation “determining whether one or more additional responses to the address inquiry signal are received from one or more of the other devices in the neighborhood group,” the Examiner asserts that *Armstrong* describes “host computer 100 or controller transmitting a Read Tag_ID command to transponders 150 and determining from the received Tag_IDs if there is a transponder 150 that has the same Tag_ID or address as another transponder 150,” citing *Armstrong*, Section [0062], lines 11-26. *Office Action mailed May 28, 2004, page 6, lines 14.* The cited passage, in relevant part, states:

If, in the course of time, an article arrives having a transponder 150 possessing the same Tag_ID as another transponder 150 currently within the population of transponders 150, host computer 100 can cause groups or individual transponders 150 to select a new Tag_ID.

The Applicant respectfully submits that the cited passage does not describe the technique with which the *Armstrong* system determines that a transponder has the same address as another transponder; instead, that technique is described in the following paragraph. The *Armstrong* reference teaches, in fact, that duplicate addresses are detected by comparison to existing addresses stored in the memory of a host computer.

At paragraph [0063], lines 1-12, the *Armstrong* reference states:

In the event that it is found that the Tag_ID of a particular transponder 150 is identical to an existing Tag_ID stored in memory in host computer 100, the Replace Tag_ID command may be used to replace the duplicate Tag_ID with a separate and distinct Tag_ID (FIG. 7). The identification of a duplicate Tag_ID must be made prior to allowing the tagged article having a duplicate Tag_ID to join the population of tagged articles containing its duplicate, e.g., there must be a staging area having a dedicated interrogator 190 which is used to identify the Tag_IDs (using the Read Tag_ID command) of tagged articles that are to be added to the general population of tagged articles. (*Emphasis added*).

Thus, the *Armstrong* reference teaches comparing a received Tag_ID to Tag_IDs stored in memory, rather than determining whether more than one response is received to an address inquiry signal, as recited in Claim 1. The cited passage makes it clear that the system described in *Armstrong* determines that a transponder has the same Tag_ID as another transponder by isolating new transponders in a separate staging area, interrogating them, and comparing their Tag_IDs with the existing Tag_IDs stored in the memory of the host computer. As such, the system of the *Armstrong* reference does not teach transmitting an address inquiry signal to the address of a first device and determining whether one or more additional responses are received from one or more other devices, as recited in Claim 1.

Neither does the *Kowalski* reference teach determining whether more than one response is received to an address inquiry signal. The reference describes modules with “identification data which are specific to the module, as for example its serial number NS.” *Kowalski, col. 4, lines 28-30.* The *Kowalski* system is solving the problem of selecting a single one from a plurality of such uniquely addressed modules in order to establish communication with the selected module. *Kowalski, col. 1, lines 8-12.* The *Kowalski* reference simply does not contemplate the possibility that more than one module may respond to a selection command addressed to a specified address.

As such, neither the *Kowalski* reference, the *Armstrong* reference, nor a combination of the *Kowalski* and *Armstrong* references disclose, suggest or hint at determining whether more than one response is received to an address inquiry signal, as recited in Claim 1.

Regarding the limitation “sending a randomize address signal addressed to ADDR1,” the Examiner asserts that the *Armstrong* method includes “transmitting a Re-select ID command or “Randomize Address” signal to a group of transponders 150 having the same Tag_ID, instructing transponders 150 to generate a random Tag_ID,” citing *Armstrong*, paragraph [0062], lines 11-26. While the cited passage describes transmitting the Reselect Tag_ID command to newly manufactured transponders having a common, default Tag_ID, the passage does not describe addressing the command to a specified address. Instead, as a succeeding passage makes clear, the Reselect Tag_ID command of the *Armstrong* reference is broadcast to all transponders within range, and acted upon by all transponders that receive the command. “Each transponder 150 which receives the Re-Select Tag_ID command generates a new candidate Tag_ID, which is based upon a random number....”

Armstrong, [0062], lines 29-30. Thus, the *Armstrong* reference teaches broadcasting the Reselect Tag_ID command to all addresses within range, rather than sending a randomize address signal addressed to ADDR1, as recited in Claim 1.

In summary, the Examiner has relied upon Official Notice of transmitting an address inquiry signal to an address in a final rejection despite the Appellant's traversal of that Notice in a previous response, failed to cite a reference that describes determining whether more than one response is received to an address inquiry signal, and failed to cite a reference that teaches sending a randomize address signal addressed to a specified address. For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellants' invention as recited in Claim 1. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 1. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 1 be withdrawn and that Claim 1 be passed to allowance.

D. **CLAIM 2**

Claim 2 recites the system of Claim 1,

wherein prior to the controller transmitting an address inquiry signal to address ADDR1 of the first device in the neighborhood, the controller in the binding process

sends a transmit address request signal to the devices in the neighborhood group and

uses a first address received from the devices in response to the address request signal as address ADDR1 of the first device in the neighborhood.

Claim 2 depends from Claim 1 and therefore includes all the limitations of Claim 1. As such, in support of the patentability of Claim 2, the Appellant incorporates by reference the arguments made with regard to the patentability of Claim 1. The Appellant submits that Claim 2 is patentable due to its dependence from an allowable base claim.

The Examiner states in the final rejection that the *Kowalski* reference describes sending a general query message to the modules, receiving an identification message from a module, sending a selection message to the module, and receiving a response from the module. The Examiner asserts that these steps teach the recited limitations of a system including a processor that sends an address request signal to devices in a neighborhood group, uses a first address received from the devices in response to the address request signal as address ADDR1 of the first device in the neighborhood, transmits an address inquiry signal to address ADDR1, and receives a response to the address inquiry signal from the first device. Assuming, without admitting, that the *Kowalski* reference teaches the recited limitations, communication will then have been established with the addressed module,

because the reference assumes a system containing uniquely addressed modules. *Kowalski, col. 4, lines 34-36.*

Should the person of ordinary skill in the art then combine the teachings of the *Armstrong* reference with those of the *Kowalski* reference, in order to address the situation of more than one module having the same identification data, that person would establish a separate interrogation zone in which to detect the duplicate data, as described in the *Armstrong* reference at paragraph [0063], lines 1-12. The combination would not result in the limitations of Claim 2 of using a first address received from neighborhood devices in response to an address request signal as address ADDR1 of a first device in the neighborhood, transmitting an address inquiry signal to address ADDR1, and determining whether more than one response is received to the address inquiry signal.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant's invention as recited in Claim 2. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 2. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 2 be withdrawn and that Claim 2 be passed to allowance.

E. **CLAIM 3**

Claim 3 recites the system of Claim 2,

wherein where the controller sends a randomize address signal addressed to ADDR1 if one or more additional responses to the address inquiry signal is received, the controller subsequently repeats the

- a) sending of the transmit address request signal to the devices in the neighborhood group,
- b) use of the first address received from the devices in response to the address request signal as address ADDR1 of the first device in the neighborhood,
- c) transmission of the address inquiry signal to address (ADDR1) of the first device in the neighborhood,
- d) receipt back of the response to the address inquiry signal from the first device,
- e) determination of whether one or more additional responses to the address inquiry signal are received from one or more of the other devices in the neighborhood, and
- f) sending of the randomize address signal addressed to ADDR1 if one or more additional responses to the address inquiry signal is received.

Claim 3 depends from Claims 1 and 2 and therefore includes all the limitations of those claims. As such, in support of the patentability of Claim 3, the Appellant incorporates by reference the arguments made with regard to the patentability of Claims 1 and 2. The Appellant submits that Claim 3 is patentable due to its dependence from allowable base claims.

Regarding the limitation that “wherein where the controller sends a randomize address signal addressed to ADDR1 if one or more additional responses to the address inquiry signal is received,” as argued with regard to Claim 1, the cited references describe neither determining whether more than one response has been received to an address inquiry signal nor sending a randomize address signal to a specified address.

Regarding actions (a)-(d), the Examiner asserts that the *Kowalski* reference teaches that such actions are repeated “in order for terminal T to select other modules that have yet to communicate with terminal T.” *Office Action mailed May 28, 2004, page 5, lines 9-10.* Thus, in the *Kowalski* system, the steps are repeated in response to successfully communicating with a single, uniquely addressed module, rather than in response to determining that more than one device has responded to a signal sent to a specified address, as recited in Claim 3.

Regarding action (f), the Examiner further asserts that in the *Armstrong* reference, the steps of transmitting a Reselect Tag_ID command to a group of transponders and transmitting a Read Tag_ID command and receiving Tag_IDs from transponders are repeated until each transponder has a unique Tag_ID. *Office Action mailed May 28, 2004, page 6, lines 4-10.* As such, the Examiner does not assert that the *Armstrong* reference teaches repeating action (e), determining whether more than one device responds to an address inquiry signal sent to a specified address. As argued with regard to Claim 1, the *Armstrong* reference teaches comparing received Tag_IDs to Tag_IDs stored in memory, rather than determining whether more than one device responds to a signal sent to a specified address.

In summary, the Examiner has failed to cite a reference that describes determining whether more than one response is received to an address inquiry signal; failed to cite a reference that teaches sending a randomize address signal addressed to a specified address; asserted that actions (a)-(d) are repeated in response to successful communication with a single module, rather than in response to determining that more than one device has responded to a signal sent to a specified address; and

failed to cite a reference that teaches repeating action (e). For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellants' invention as recited in Claim 3. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 3. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 3 be withdrawn and that Claim 3 be passed to allowance.

F. **CLAIM 12**

Claim 12 recites

a method of binding one or more devices from a neighborhood group into a control group that are controlled together, each device having an address, the method comprising the steps of

- a) requesting the addresses of the devices in the neighborhood group;
- b) considering a first address received from the devices in response to the address request as an address (ADDR1) of a first device in the neighborhood group;
- c) querying the devices in the neighborhood group whether they have address ADDR1 of the first device in the neighborhood;
- d) receiving a response to the query of step c from the first device;
- e) determining whether one or more additional responses to the query of step c are received from one or more of the other devices in the neighborhood group; and
- f) instructing all devices having address ADDR1 to randomize their addresses when one or more additional responses to the query of step c is determined to be received in step e.

Regarding steps (a)-(d) of the claimed method, the Examiner states in the final rejection that the *Kowalski* reference describes sending a general query message to the modules, receiving an identification message from a module, sending a selection message to the module, and receiving a response from the module. The Examiner asserts that these steps teach the recited limitations of requesting the addresses of devices in a neighborhood group, considering a first address received

from the devices in response to the address request signal as address ADDR1 of the first device in the neighborhood, querying the devices in the neighborhood group whether they have address ADDR1, and receiving a response to the query from the first device. Assuming, without admitting, that the *Kowalski* reference teaches the recited limitations, communication will then have been established with the addressed module, because the reference assumes a system containing uniquely addressed modules. *Kowalski, col. 4, lines 34-36.*

Should the person of ordinary skill in the art then combine the teachings of the *Armstrong* reference with those of the *Kowalski* reference, in order to address the situation of more than one module having the same identification data, that person would establish a separate interrogation zone in which to detect the duplicate data, as described in the *Armstrong* reference at paragraph [0063], lines 1-12. The combination would not result in the limitations of Claim 12 of using a first address received from neighborhood devices in response to an address request as address ADDR1 of a first device in the neighborhood, querying the devices in the neighborhood group whether they have address ADDR1, and determining whether more than one response is received to the address inquiry signal.

Regarding the limitation “querying the devices in the neighborhood group whether they have address ADDR1,” the Examiner asserts that “the common knowledge of controllers transmitting interrogation signals addressed to specific transponders is taken to be admitted prior art since the Applicant failed to traverse the examiner’s assertion of official notice in the previous Office Action.” *Office Action mailed May 28, 2004, page 5, lines 12-15.* The Applicant traverses this assertion.

The Examiner's actual statement in the previous Office Action was, "Though Kowalski's method lacks the step of sending an interrogation signal or address inquiry signal to determine the presence of modules having a specific address, the Examiner takes Official Notice that controllers with the ability to determine whether a specifically addressed transponder is present are well known." *Office Action mailed December 10, 2003, page 6, lines 5-8.* In the Applicant's response to the previous Office Action, the Applicant stated, "The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response." *Applicant's Response to Office Action mailed December 10, 2003, page 20, last two lines.* Thus, the Applicant properly traversed the Examiner's assertion of Official Notice and the asserted common knowledge is improperly treated as admitted prior art in the final rejection.

The Applicant respectfully submits that the assertions made in the Official Notice are not "capable of instant and unquestionable demonstration as being well-known" as required by M.P.E.P. § 2144.03. The Applicant respectfully requests that the Patent Office provide documentary evidence showing that the limitation of "querying the devices in the neighborhood group whether they have [an] address," as recited in Claim 12, is actually "well known in the art" as asserted in the Office Action.

Regarding the limitation "determining whether one or more additional responses to the query of step c are received from one or more of the other devices in the neighborhood group," the Examiner asserts that *Armstrong* describes "host computer 100 or controller transmitting a Read Tag_ID command to transponders 150 and determining from the received Tag_IDs if there is a

transponder 150 that has the same Tag_ID or address as another transponder 150," citing *Armstrong*, Section [0062], lines 11-26. *Office Action mailed May 28, 2004, page 6, lines 14.* The cited passage, in relevant part, states:

If, in the course of time, an article arrives having a transponder 150 possessing the same Tag_ID as another transponder 150 currently within the population of transponders 150, host computer 100 can cause groups or individual transponders 150 to select a new Tag_ID.

The Applicant respectfully submits that the cited passage does not describe the technique with which the *Armstrong* system determines that a transponder has the same address as another transponder; instead, that technique is described in the following paragraph. The *Armstrong* reference teaches, in fact, that duplicate addresses are detected by comparison to existing addresses stored in the memory of a host computer.

At paragraph [0063], lines 1-12, the *Armstrong* reference states:

In the event that it is found that the Tag_ID of a particular transponder 150 is identical to an existing Tag_ID stored in memory in host computer 100, the Replace Tag_ID command may be used to replace the duplicate Tag_ID with a separate and distinct Tag_ID (FIG. 7). The identification of a duplicate Tag_ID must be made prior to allowing the tagged article having a duplicate Tag_ID to join the population of tagged articles containing its duplicate, e.g., there must be a staging area having a dedicated interrogator 190 which is used to identify the Tag_IDs (using the Read Tag_ID command) of tagged articles that are to be added to the general population of tagged articles. (*Emphasis added*).

Thus, the *Armstrong* reference teaches comparing a received Tag_ID to Tag_IDs stored in memory, rather than determining whether more than one response is received to query as to whether devices have a specified address, as recited in Claim 12. The cited passage makes it clear that the system described in *Armstrong* determines that a transponder has the same Tag_ID as another transponder

by isolating new transponders in a separate staging area, interrogating them, and comparing their Tag_IDs with the existing Tag_IDs stored in the memory of the host computer. As such, the system of the *Armstrong* reference does not teach querying the devices in the neighborhood group whether they have a specified address and determining whether more than one response is received, as recited in Claim 12.

Neither does the *Kowalski* reference teach determining whether more than one response is received to a query as to whether devices have a specified address. The reference describes modules with “identification data which are specific to the module, as for example its serial number NS.” *Kowalski, col. 4, lines 28-30.* The *Kowalski* system is solving the problem of selecting a single one from a plurality of such uniquely addressed modules in order to establish communication with the selected module. *Kowalski, col. 1, lines 8-12.* The *Kowalski* reference simply does not contemplate the possibility that more than one module may respond to a selection command addressed to a specified address.

As such, neither the *Kowalski* reference, the *Armstrong* reference, nor a combination of the *Kowalski* and *Armstrong* references disclose, suggest or hint at determining whether more than one response is received to a query as to whether devices have a specified address, as recited in Claim 12.

Regarding the limitation “instructing all devices having address ADDR1 to randomize their addresses,” the Examiner asserts that the *Armstrong* method includes “transmitting a Re-select ID command or “Randomize Address” signal to a group of transponders 150 having the same Tag_ID, instructing transponders 150 to generate a random Tag_ID,” citing *Armstrong*, paragraph [0062],

lines 11-26. While the cited passage describes transmitting the Reselect Tag_ID command to newly manufactured transponders having a common, default Tag_ID, the passage does not describe instructing all transponders having a specified address to randomize their addresses. Instead, as a succeeding passage makes clear, the Reselect Tag_ID command of the *Armstrong* reference is broadcast to all transponders within range, and acted upon by all transponders that receive the command. “Each transponder 150 which receives the Re-Select Tag_ID command generates a new candidate Tag_ID, which is based upon a random number....” *Armstrong, [0062], lines 29-30.* Thus, the *Armstrong* reference teaches instructing all transponders within range to randomize their addresses, rather than instructing only devices having a specified address to randomize their addresses, as recited in Claim 12.

In summary, the Examiner has failed to show that the combination of the cited prior art teaches using a first address received from neighborhood devices in response to an address request as address ADDR1 of a first device in the neighborhood, querying the devices in the neighborhood group whether they have address ADDR1, and determining whether more than one response is received to the address inquiry signal. Furthermore, the Examiner has relied upon Official Notice in a final rejection despite the Appellant’s traversal of that Notice in a previous response, failed to cite a reference that describes determining whether more than one response is received to a query as to whether devices have a specified address, and failed to cite a reference that teaches sending a randomize address signal addressed to a specified address. For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellants’ invention as recited in Claim

12. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 12. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 12 be withdrawn and that Claim 12 be passed to allowance.

G. CLAIM 13

Claim 13 recites the method of Claim 12,

wherein step f further comprises instructing the first device to mark itself as unavailable when no additional responses to the query of step c are determined to be received in step e;

wherein only devices marked as available respond to the address request of step a and steps a to f are repeated until it is determined in step e that no additional responses to the query of step c are received.

Claim 13 depends from Claim 12 and therefore includes all the limitations of Claim 12. As such, in support of the patentability of Claim 13, the Appellant incorporates by reference the arguments made with regard to the patentability of Claim 12. The Appellant submits that Claim 13 is patentable due to its dependence from an allowable base claim.

Regarding the limitation that step (f) of the method further comprises “instructing the first device to mark itself as unavailable when no additional responses to the query of step c are determined to be received in step e,” as argued with regard to Claim 12, the cited references do not describe determining whether more than one response has been received to a query as to whether devices have a specified address. As such, the cited references cannot teach performing a step of the claimed method when no additional responses to the query are determined to be received.

Regarding actions (a)-(d), the Examiner asserts that the *Kowalski* reference teaches that such actions are repeated “in order for terminal T to select other modules that have yet to communicate with terminal T.” *Office Action mailed May 28, 2004, page 5, lines 9-10.* Thus, in the *Kowalski* system, the steps are repeated in response to successfully communicating with a single, uniquely addressed module, rather than in response to determining that more than one device has responded to a query as to whether devices have a specified address, as recited in Claim 12.

Regarding action (f), the Examiner further asserts that in the *Armstrong* reference, the steps of transmitting a Reselect Tag_ID command to a group of transponders and transmitting a Read Tag_ID command and receiving Tag_IDs from transponders are repeated until each transponder has a unique Tag_ID. *Office Action mailed May 28, 2004, page 6, lines 4-10.* As such, the Examiner does not assert that the *Armstrong* reference teaches repeating action (e), determining whether more than one device responds to a query as to whether devices have a specified address. As argued with regard to Claim 12, the *Armstrong* reference teaches comparing received Tag_IDs to Tag_IDs stored in memory, rather than determining whether more than one device responds to a query as to whether devices have a specified address.

In summary, the Examiner has failed to cite a reference that describes instructing a device to mark itself as unavailable upon determining that only one response has been received to a query as to whether devices have a specified address; asserted that actions (a)-(d) are repeated in response to successful communication with a single module, rather than in response to determining that more

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than one device has responded to a signal sent to a specified address; and failed to cite a reference that teaches repeating action (e). For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellants' invention as recited in Claim 13. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 13. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 13 be withdrawn and that Claim 13 be passed to allowance.

GROUND 2 – REJECTION UNDER 35 U.S.C. § 103(a) OF CLAIMS 4 AND 14-16

The rejection of Claims 4 and 14-16 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

A. OVERVIEW

Claims 4 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,337,619 to Kowalski et al (“*Kowalski*”) in view of U.S. Patent Application No. 2002/0175705 A9 to Armstrong et al. (“*Armstrong*”) in further view of U.S. Patent No. 6,133,832 to Winder et al. (“*Winder*”).

B. STANDARD

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Appellant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does

not produce a *prima facie* case of unpatentability, then without more the Appellant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. (MPEP § 2142).

C. **CLAIM 4**

Claim 4 recites the system of Claim 3,

wherein where the controller receives back the response to the address inquiry signal from the first device and no additional responses to the address inquiry signal, the controller in the binding process subsequently sends an identify request signal addressed to ADDR1 that instructs the first device to provide a sensory output that identifies itself to an operator of the controller.

Claim 4 depends from Claims 1-3 and therefore includes all the limitations of those claims.

As such, in support of the patentability of Claim 4, the Appellant incorporates by reference the arguments made with regard to the patentability of Claims 1-3. Furthermore, the *Winder* reference does nothing to overcome the shortcomings of the *Kowalski* and *Armstrong* references. The Appellant submits that Claim 4 is patentable due to its dependence from allowable base claims.

Regarding the limitation that the controller sends an identify request signal in response to receiving only a single response to an address inquiry signal, as argued with regard to Claim 1, the cited references describe neither determining whether more than one response has been received to an address inquiry signal.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant's invention as recited in Claim 4. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 4. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 4 be withdrawn and that Claim 4 be passed to allowance.

D. **CLAIM 14**

Claim 14 recites the method of Claim 13,

wherein, after it is determined in step e that no additional responses to the query of step c are received, the method further comprises the step of:

g) instructing the first device to provide a sensory output that identifies the first device to an operator.

Claim 14 depends from Claims 12 and 13 and therefore includes all the limitations of those claims. As such, in support of the patentability of Claim 14, the Appellant incorporates by reference the arguments made with regard to the patentability of Claims 12 and 13. Furthermore, the *Winder* reference does nothing to overcome the shortcomings of the *Kowalski* and *Armstrong* references. The Appellant submits that Claim 14 is patentable due to its dependence from allowable base claims.

Regarding the limitation that the method further comprises the step of instructing a device to provide a sensory output when it is determined that only one response to the query of step (c) has been received, as argued with regard to Claim 12, the cited references do not describe determining whether more than one response has been received to a query as to whether devices have a specified address. As such, the cited references cannot teach performing a step of the claimed method when no additional responses to the query are determined to be received.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant's invention as recited in Claim 14. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 14. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 14 be withdrawn and that Claim 14 be passed to allowance.

E. **CLAIM 15**

Claim 15 recites the method of Claim 14,

further comprising the steps of:

- h) binding the first device as part of the control group;
- i) removing the first device from further consideration in the binding procedure; and
- j) repeating the method beginning with step a.

Claim 15 depends from Claims 12-14 and therefore includes all the limitations of those claims. As such, in support of the patentability of Claim 15, the Appellant incorporates by reference the arguments made with regard to the patentability of Claims 12-14. Furthermore, the *Winder* reference does nothing to overcome the shortcomings of the *Kowalski* and *Armstrong* references. The Appellant submits that Claim 15 is patentable due to its dependence from allowable base claims.

Regarding the limitation of “binding the first device as part of the control group,” the Examiner asserts that the *Kowalski* reference describes a module in an EXEC state as a bound module. However, the Applicant submits that the object of the *Kowalski* system is to select a single electronic module from a plurality of modules, in order to establish communication between a terminal and the selected module. *Kowalski, col. 1, lines 8-12*. Thus, the teaching of the *Kowalski* reference is to establish communication with a single module, rather than bind the module to a group, as recited in Claim 15.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant’s invention as recited in Claim 15. As a result, the Examiner has failed to establish a

prima facie case of obviousness against Claim 15. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 15 be withdrawn and that Claim 15 be passed to allowance.

F. **CLAIM 16**

Claim 16 recites the method of Claim 14,

further comprising the steps of:

- h) removing the first device from further consideration in the binding procedure without binding the first device as part of the control group; and
- i) repeating the method beginning with step a.

Claim 16 depends from Claims 12-14 and therefore includes all the limitations of those claims. As such, in support of the patentability of Claim 16, the Appellant incorporates by reference the arguments made with regard to the patentability of Claims 12-14. Furthermore, the *Winder* reference does nothing to overcome the shortcomings of the *Kowalski* and *Armstrong* references. The Appellant submits that Claim 16 is patentable due to its dependence from allowable base claims.

With regard to the limitation of “removing the first device from further consideration in the binding procedure without binding the first device as part of the control group,” the Examiner asserts that the *Kowalski* reference describes a module in the SEL state as unbound and a module in the EXEC state as bound. The Appellant submits that *Kowalski* actually teaches that, once a module enters the SEL state, “it can be considered that the communication is established with the terminal, the other modules remaining silent.” *Kowalski, col. 8, lines 18-19*. A module then enters the EXEC state when operating commands are actually send to the module. *Kowalski, col. 8, lines 20-21*. As such, the *Kowalski* reference describes a system that brings a single module from a plurality of

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modules under control by placing it into the SEL state, thereby excluding all other modules from control. The Examiner's distinction between the SEL and EXEC states as representing unbound or bound states is thus an artificial one.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant's invention as recited in Claim 16. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 16. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 16 be withdrawn and that Claim 16 be passed to allowance.

GROUND 3 – REJECTION UNDER 35 U.S.C. § 103(a) OF CLAIMS 9 AND 10

The rejection of Claims 9 and 10 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

A. OVERVIEW

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0175705 A9 to Armstrong et al. (“*Armstrong*”) in view of U.S. Patent No. Patent No. 5,838,226 to Houggly et al. (“*Houggly*”).

B. STANDARD

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Appellant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Appellant is entitled to grant

of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. (MPEP § 2142).

C. **CLAIM 9**

Claim 9 recites a device that may be bound to a wireless controller, the device comprising a processor having an address and a transceiver over which signals are transmitted and received, the processor in a binding procedure programmed to

- a) transmit a signal comprising the address a pre-determined period of time after receipt of an address request signal,
- b) randomize its address in response to receipt of a randomize address signal,
- c) transmit a responding signal in response to receipt of an address inquiry signal addressed to the address.

With regard to the limitation that the processor is programmed transmit a signal “a pre-determined period of time after receipt of an address request signal,” the Examiner asserts that the description in the *Hougg* reference of a lighting control device transmitting its status information in an assigned timeslot teaches the claimed limitation. The Appellant respectfully submits that the Examiner misunderstands the teaching of the *Hougg* reference. The time slots of the *Hougg* system are synchronized to the zero crossings of the AC power supplied to the master station. *Hougg*, col. 29, lines 65-67. The *Hougg* dimmer operates in the same way. *Hougg*, col. 30, lines 44-47. Thus, the point in time at which a dimmer in the *Hougg* system transmits its status is determined by the timing of a subsequent zero crossing of the AC power line, rather than by the passing of a pre-determined period of time after the receipt of a command, as recited in Claim 9.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant’s invention as recited in Claim 9. As a result, the Examiner has failed to establish a

prima facie case of obviousness against Claim 9. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 9 be withdrawn and that Claim 9 be passed to allowance.

D. CLAIM 10

Claim 10 recites the device of Claim 9,

wherein the processor in the binding procedure is further programmed to re-program the address upon receipt of a signal addressed to the address and comprising a new address.

Claim 10 depends from Claim 9 and therefore includes all the limitations of Claim 9. As such, in support of the patentability of Claim 10, the Appellant incorporates by reference the arguments made with regard to the patentability of Claim 9. The Appellant submits that Claim 10 is patentable due to its dependence from an allowable base claim.

With regard to the limitation that the processor is programmed to “re-program the address upon receipt of a signal addressed to the address and comprising a new address,” the Examiner asserts that the *Armstrong* reference describes a transponder that receives a command including a new Tag_ID, stores the Tag_ID in temporary storage, and replaces its old Tag_ID with the new Tag_ID upon the subsequent receipt of an acknowledgement signal. As such, the *Armstrong* system reprograms a transponder’s Tag_ID using two signals, one to communicate the new Tag_ID and another to cause the reprogramming of the Tag_ID in the transponder. Thus, the Applicant submits that the *Armstrong* reference does not, in fact, describe a processor programmed to reprogram its address upon receipt of a signal comprising a new address, as recited in Claim 10.

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For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant's invention as recited in Claim 10. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 10. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 10 be withdrawn and that Claim 10 be passed to allowance.

GROUND 4 – REJECTION UNDER 35 U.S.C. § 103(a) OF CLAIM 11

The rejection of Claim 11 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

A. OVERVIEW

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0175705 A9 to Armstrong et al. (“*Armstrong*”) in view of U.S. Patent No. Patent No. 5,838,226 to Houggy et al. (“*Houggy*”) and further in view of U.S. Patent Application No. 2002/0084890 A1 to Guerrieri et al. (“*Guerrieri*”).

B. STANDARD

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Appellant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Appellant is entitled to grant

of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. (MPEP § 2142).

C. CLAIM 11

Claim 11 recites the device of Claim 10, wherein the device is a lamp.

Claim 11 depends from Claims 9 and 10 and therefore includes all the limitations of those claims. As such, in support of the patentability of Claim 11, the Appellant incorporates by reference the arguments made with regard to the patentability of Claims 9 and 10. Furthermore, the *Guerrieri* reference does nothing to overcome the shortcomings of the *Armstrong* and *Houggly* references. The Appellant submits that Claim 11 is patentable due to its dependence from allowable base claims.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant's invention as recited in Claim 11. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 11. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 11 be withdrawn and that Claim 11 be passed to allowance.

GROUND 5 – REJECTION UNDER 35 U.S.C. § 103(a) OF CLAIM 17

The rejection of Claim 17 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

A. OVERVIEW

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,337,619 to Kowalski et al (“*Kowalski*”) in view of U.S. Patent Application No. 2002/0175705 A9 to Armstrong et al. (“*Armstrong*”) and further in view of U.S. Patent Application No. 2002/0084890 A1 to Guerrieri et al. (“*Guerrieri*”).

B. STANDARD

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Appellant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Appellant is entitled to grant

of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. (MPEP § 2142).

C. **CLAIM 17**

Claim 17 recites the method of Claim 12, wherein the device is a lamp.

Claim 17 depends from Claim 12 and therefore includes all the limitations of Claim 12. As such, in support of the patentability of Claim 17, the Appellant incorporates by reference the arguments made with regard to the patentability of Claim 12. Furthermore, the *Guerrieri* reference does nothing to overcome the shortcomings of the *Kowalski* and *Armstrong* references. The Appellant submits that Claim 17 is patentable due to its dependence from an allowable base claim.

For these reasons, the Examiner has not shown that the prior art discloses, teaches or suggests the Appellant's invention as recited in Claim 17. As a result, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 17. Accordingly, the Appellant respectfully requests that the § 103 rejection of Claim 17 be withdrawn and that Claim 17 be passed to allowance.

CONCLUSION

The Appellants have demonstrated that the present invention as claimed is clearly distinguishable over the prior art cited of record. Therefore, the Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Appellants have enclosed a check in the amount of \$330.00 to cover the cost of this Appeal Brief. The Appellants do not believe that any additional fees are due. However, the Commissioner is hereby authorized to charge any additional fees (including any extension of time fees) or credit any overpayments to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Nov. 23, 2004



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APPENDIX A

CLAIMS APPENDIX

1. A system comprising a wireless controller that binds one or more devices from a neighborhood group of devices to the controller, the controller having a processor that processes data and formats signals and a transceiver that transmits and receives signals, the controller in a binding procedure transmitting an address inquiry signal to an address (ADDR1) of a first device in the neighborhood, receiving back a response to the address inquiry signal from the first device, determining whether one or more additional responses to the address inquiry signal are received from one or more of the other devices in the neighborhood group, and sending a randomize address signal addressed to ADDR1 if one or more additional responses to the address inquiry signal is received.

2. The system as in Claim 1, wherein prior to the controller transmitting an address inquiry signal to address ADDR1 of the first device in the neighborhood, the controller in the binding process sends a transmit address request signal to the devices in the neighborhood group and uses a first address received from the devices in response to the address request signal as address ADDR1 of the first device in the neighborhood.

3. The system as in Claim 2, wherein where the controller sends a randomize address signal addressed to ADDR1 if one or more additional responses to the address inquiry signal is

received, the controller subsequently repeats the a) sending of the transmit address request signal to the devices in the neighborhood group, b) use of the first address received from the devices in response to the address request signal as address ADDR1 of the first device in the neighborhood, c) transmission of the address inquiry signal to address (ADDR1) of the first device in the neighborhood, d) receipt back of the response to the address inquiry signal from the first device, e) determination of whether one or more additional responses to the address inquiry signal are received from one or more of the other devices in the neighborhood, and f) sending of the randomize address signal addressed to ADDR1 if one or more additional responses to the address inquiry signal is received.

4. The system as in Claim 3, wherein where the controller receives back the response to the address inquiry signal from the first device and no additional responses to the address inquiry signal, the controller in the binding process subsequently sends an identify request signal addressed to ADDR1 that instructs the first device to provide a sensory output that identifies itself to an operator of the controller.

5. The system as in Claim 4, wherein following receipt of the output identification of the first device, the operator inputs one of a bind command and a skip command, the bind command causing the controller to bind the first device to a control group of devices controlled by the controller and the skip command causing the controller to leave the first device unbound.

6. The system as in Claim 5, wherein the binding of the first device to the control group in response to the bind command comprises storing a unique address for the first device in memory.

7. The system as in Claim 6, wherein the binding of the first device to the control group in response to the bind command further comprises the controller transmitting a signal addressed to the first device at ADDR1 instructing the first device to re-program its address from ADDR1 to the unique address.

8. The system as in Claim 7, wherein the devices are lamps.

9. A device that may be bound to a wireless controller, the device comprising a processor having an address and a transceiver over which signals are transmitted and received, the processor in a binding procedure programmed to a) transmit a signal comprising the address a pre-determined period of time after receipt of an address request signal, b) randomize its address in response to receipt of a randomize address signal, c) transmit a responding signal in response to receipt of an address inquiry signal addressed to the address.

10. The device as in Claim 9, wherein the processor in the binding procedure is further programmed to re-program the address upon receipt of a signal addressed to the address and comprising a new address.

11. The device as in Claim 10, wherein the device is a lamp.

12. A method of binding one or more devices from a neighborhood group into a control group that are controlled together, each device having an address, the method comprising the steps of

- a) requesting the addresses of the devices in the neighborhood group;
- b) considering a first address received from the devices in response to the address request as an address (ADDR1) of a first device in the neighborhood group;
- c) querying the devices in the neighborhood group whether they have address ADDR1 of the first device in the neighborhood;
- d) receiving a response to the query of step c from the first device;
- e) determining whether one or more additional responses to the query of step c are received from one or more of the other devices in the neighborhood group; and
- f) instructing all devices having address ADDR1 to randomize their addresses when one or more additional responses to the query of step c is determined to be received in step e.

13. The method as in Claim 12, wherein step f further comprises instructing the first device to mark itself as unavailable when no additional responses to the query of step c are determined to be received in step e;

wherein only devices marked as available respond to the address request of step a and steps a to f are repeated until it is determined in step e that no additional responses to the query of step c are received.

14. The method as in Claim 13, wherein, after it is determined in step e that no additional responses to the query of step c are received, the method further comprises the step of:

g) instructing the first device to provide a sensory output that identifies the first device to an operator.

15. The method as in Claim 14, further comprising the steps of:

h) binding the first device as part of the control group;

i) removing the first device from further consideration in the binding procedure; and

j) repeating the method beginning with step a.

16. The method as in Claim 14, further comprising the steps of:

h) removing the first device from further consideration in the binding procedure without binding the first device as part of the control group; and

i) repeating the method beginning with step a.

17. The method as in Claim 12, wherein the devices are lamps.

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APPENDIX B

EVIDENCE APPENDIX

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APPENDIX C

RELATED PROCEEDINGS APPENDIX

There are no known appeals or interferences that are related to, will directly affect, be directly affected by, or have a bearing on the Board's decision in this pending appeal.